

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN W. STONE

Appeal No. 96-1511
Application 08/063,919¹

ON BRIEF

Before CALVERT, STAAB, and McQUADE, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed May 18, 1993. According to appellant, the application is a continuation-in-part of application 07/978,130, filed November 18, 1992; which is a continuation-in-part of Application 29/001,639, filed November 18, 1992.

This appeal is from the final rejection of claims 1 through 5, 7 through 12 and 16 through 20, all of the claims pending in the application.²

The invention relates to "a holder device for securely retaining a writing implement, such as a pen, pencil, marker and the like, to a support surface, such as at a location nearby to a telephone, copy machine, notebook, etc." (specification, page 5). Claim is 1 illustrative and reads as follows:

1. A holder device mountable on a support surface of a support and adapted to removably secure elongated writing implements thereto, the holder device comprising:

a base portion having opposite lateral edges and adapted to mount on said support surface; and

a pair of resilient wing portions each jointed to said base portion longitudinally along a junction location, said wing portions extending away from said base portion and converging toward one another to terminate in a free wing edge so that said wing portions and said base portion define a longitudinally extending channel sized to receive an elongated writing implement, said channel having opposite open ends and a longitudinal mouth located between said wing edges whereby said writing implement may be inserted through said mouth and retained within said channel, and including a longitudinal groove formed proximate to each respective junction location in said channel,

said grooves operative to permit deflection of said wing portions away from one another thereby to reduce bending moments of force on said base portion when said writing implement is inserted through said mouth.

² Claim 1 has been amended subsequent to final rejection.

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The references relied upon by the examiner as evidence of obviousness are:

Copell	2,161,855	Jun. 13, 1939
Frank	3,154,281	Oct. 27, 1964
Wolsh	3,228,640	Jan. 11, 1966
Andre	4,614,321	Sep. 30, 1986
Engvall	5,178,354	Jan. 12, 1993
		(filed Jan. 21, 1992)
Clay	461,277	Feb. 15, 1937
(British Patent Document)		

The claims on appeal stand rejected under 35 U.S.C. § 103 as follows:³

a) claims 1, 2 and 8 as being unpatentable over Engvall in view of Andre;

b) claims 1, 2 and 7 as being unpatentable over Engvall in view of Copell;

c) claim 11 as being unpatentable over Engvall in view of either Andre or Copell, and further in view of Clay;

d) claim 11 as being unpatentable over Frank in view of either Andre or Copell, and further in view of Clay;

³ Some of these rejections were carried forward from the final rejection (Paper No. 9) into the main answer (Paper No. 13) and some were entered for the first time in the main answer. Certain rejections made in the final rejection were not carried forward into the main answer and are assumed to have been withdrawn by the examiner (see Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957)).

e) claims 12 and 19 as being unpatentable over Wolsh in view of Clay;

f) claims 16 and 18 as being unpatentable over Wolsh in view of Clay, and further in view of Andre;

g) claims 16 and 17 as being unpatentable over Wolsh in view of Clay, and further in view of Copell;

h) claim 20 as being unpatentable over Engvall in view of Clay;

i) claims 1, 3 through 5, 8 through 10, 12, 16, 18 and 19 as being unpatentable over Frank in view of Andre;

j) claims 1, 3 through 5, 7, 9, 10, 12, 16, 17 and 19 as being unpatentable over Frank in view of Copell;

k) claims 1, 3 through 5, 8, 9, 11, 12, 16 and 18 through 20 as being unpatentable over Wolsh in view of Andre; and

l) claims 1, 3 through 5, 7, 9, 11, 12, 16, 17, 19 and 20 as being unpatentable over Wolsh in view of Copell.

Reference is made to the appellant's main and reply briefs (Paper Nos. 11 and 14) and to the examiner's main and supplemental answers (Paper Nos. 13 and 15) for the respective positions of the appellant and the examiner with regard to the propriety of these rejections.

Having carefully considered the content of the claims on appeal, the scope of the applied prior art and the respective viewpoints advanced by the appellant and the examiner, we shall not sustain any of the examiner's rejections.

The manner in which the examiner has combined the references applied in support of the various rejections (see pages 3 through 9 in the main answer) indicates that the proposed combinations are based on improper hindsight rather than on the teachings, suggestions and inferences of the references themselves. Thus, the rejections as set forth by the examiner are fundamentally unsound.

More particularly, the examiner justifies the proposed combinations of Engvall or Frank or Wolsh in view of Andre or Copell (rejections a, b, c, d, f, g, i, j, k and l) by concluding that it would have been obvious to one of ordinary skill in the art to modify the holder devices disclosed in the primary references by incorporating grooves as in Andre or Copell to provide the holding devices with a more secure retention capability. Neither Andre nor Copell, however, teaches or suggests that the grooves in the devices disclosed therein provide this capability.

The examiner justifies the proposed combination of Wolsh in view of Clay (rejection e) by concluding that it would have been obvious to one of ordinary skill in the art to modify the truss-engaging clip portion of Wolsh's molded plastic pipe-holding device by configuring it in accordance with the suitcase-engaging clip portion of Clay's metallic strip umbrella-holding device "to better hold the [Wolsh] device adjacent another member" (main answer, page 5). The examiner does not explain, however, nor do Wolsh and Clay teach or suggest, why such a modification would enhance the clip portion of Wolsh's device.

Finally, the examiner justifies the proposed combination of Engvall in view of Clay (rejection h) by concluding that it would have been obvious to one of ordinary skill in the art to modify the holder device disclosed by Engvall by incorporating lobes as in Clay to provide the device with a more secure retention capability. Here again, however, Clay does not teach or suggest that the lobes on the device disclosed therein provide this capability.

The following rejections are entered pursuant to 37 CFR § 1.196(b).

Claims 1, 2 and 7 through 9 are rejected under 35 U.S.C. § 103 as being unpatentable over Copell in view of Engvall.

Copell discloses a general purpose holder device for receiving and holding articles such as "pipes, tooth brushes, toilet appliances and similar elements" (page 1, column 2, lines 8 through 10). The device consists of a body 10 preferably made of rubber or a similar material. The body includes an opening 12 for receiving the article and carries a mounting strip 17 which may be embedded into the surface of an underlying support to affix the body thereto. The opening 12 may define recesses or grooves 13 to accommodate oval-shaped articles. As best shown in Figure 3, Copell's body has a base portion, a pair of resilient wing portions joined to the base portion along a junction location, and a longitudinally extending channel having opposite open ends and a longitudinal mouth.

Copell's holder device meets all of the limitations in claims 1, 2 and 7 through 9 except for those requiring the base portion to have opposite lateral edges (claim 1) and an adhesive layer on its bottom surface (claim 2), and the grooves to be triangular in cross-section (claim 8). In this regard, the base portion of Copell's device lacks any apparent opposite lateral edges and adhesive on its bottom surface, and Copell's recesses or grooves 13 are semi-circular in cross-section.

The appellant's arguments that Copell's recesses or grooves are not located proximate the respective junction locations between the wing and base portions and would not permit deflection of the wing portions away from one another to reduce bending moments on the base portion as recited in claim 1 (see, for example, page 8 and 9 in the main brief and page 4 in the reply brief) are not well taken. Copell's Figure 3 clearly shows that grooves 13 are located proximate the respective junction locations between the wing and base portions as broadly recited in claim 1. Moreover, it is not apparent, nor has the appellant pointed out, why such grooves would not function to permit deflection of the wing portions away from one another to reduce bending moments on the base portion.

Engvall discloses a holder device adapted to be secured to an aerosol can to hold an extension tube while not in use. As described by Engvall,

[w]hile the holder 10 is intended to be affixed to an aerosol container, and is intended to hold an extension tube, it will become apparent to those skilled in the art that the holder may be affixed to other supporting surfaces, and that the inventive holder could be adapted to support other types and kinds of rodlike members, such as broom handles, tool handles, and others.

With reference now to FIGS. 2-4, the tube holder 10 has a base 14, with an adhesive layer 21 on the

underside thereof, for attaching the tube holder to the surface of the can 5. . . .

A pair of spaced apart, upstanding tube grasping members 18 and 19, are integrally connected to the top surface of the base 14. As best seen in FIG. 3, a spacing 15 between the members 18 and 19 is suitably dimensioned to receive the rodlike tube 12 therewithin. The spacing 15 has at the top edges of the members 18 and 19, a width H which is just slightly less than the outside diameter of the tube 12. As shown in FIG. 3, the members 18 and 19 are inclined slightly toward one another, and are composed of resilient material [column 4, line 45 through column 5, line 3].

As best illustrated in Figure 2, the base 14 has a rectangular shape defined by a pair of relatively long opposite lateral edges and relatively short opposite end edges.

It would have been obvious to one of ordinary skill in the art to modify the holder device disclosed by Copell by providing it with a rectangular base portion having opposite lateral edges and adhesive on its bottom surface as taught by Engvall in order to adapt the device for adhesive connection to an underlying support surface. The resulting holder device would meet all of the limitations in claims 1, 2, 7 and 9.

It also would have been an obvious matter of design choice within the skill of the art to make Copell's semi-circular recesses 13 triangular in cross-section as recited in claim 8. The triangular recess cross-section has not been disclosed or

established by the appellant as solving a stated problem or presenting a novel or unexpected result (see In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 8-9 (CCPA 1975)) and would serve Copell's objective of adapting the holder device to receive oval-shaped articles.

Claim 10 is rejected under 35 U.S.C. § 103 as being unpatentable over Copell in view of Engvall, and further in view of Frank.

The Copell holder device as modified in view of Engvall does not meet the limitation in claim 10 requiring that each wing portion uniformly taper from the base portion to its free wing edge.

Frank discloses a holder device for articles such as electronic components. The device is made of a resilient material and includes a body or base portion 16 and two arms or wing portions 22 extending upwardly from the body portion to receive the article. As shown in Figure 2, the arms or wing portions taper from the body portion to their free edges.

It would have been obvious to one of ordinary skill in the art in view of Frank to so taper the wing portions of the Copell holder device as modified in view of Engvall, thereby arriving at

the subject matter recited in claim 10, in order to achieve the self-evident advantages of wing portions which require less material and are easier to flex.

Claim 11 is rejected under 35 U.S.C. § 103 as being unpatentable over Copell in view of Engvall, and further in view of Clay.

The Copell holder device as modified in view of Engvall does not meet the limitation in claim 11 requiring the wing portions to terminate in enlarged longitudinally extending lobes.

Clay discloses a holder device "for attaching umbrellas, and other suitable articles to suitcases and similar articles" (page 1, lines 6 through 8). The device is made of a resilient strip of sheet metal and includes a base portion and two arm or wing portions extending upwardly from the base portion to receive the article. As shown in Figures 1 and 2, wing portions terminate in enlarged lobes or beads 13, 14 to prevent damage to the articles (see page 2, lines 94 through 96).

It would have been obvious to one of ordinary skill in the art in view of Clay to terminate the wing portions of the Copell holder device as modified in view of Engvall in lobes, thereby arriving at the subject matter recited in claim 11, in order to prevent damage to the articles held thereby. The record does not

support the appellant's contention (see page 13 in the main brief) that holder devices such as those disclosed by Copell do not require lobes to prevent damage to the articles.

Claim 20 is rejected under 35 U.S.C. § 103 as being unpatentable over Copell in view of Engvall, and further in view of Frank and Clay.

The Copell holder device as modified in view of Engvall meets all of the limitations in claim 20 except or that requiring each wing portion to taper in cross-section with each free wing edge formed as an enlarged longitudinally extending lobe.

For the reasons discussed above, it would have been obvious to one of ordinary skill in the art to modify the holder device of Copell as modified in view of Engvall by tapering its wing portions in view of Frank and by terminating same in lobes in view of Clay, thereby arriving at the holder device recited in claim 20.

In summary:

a) the decision of the examiner to reject claims 1 through 5, 7 through 12 and 16 through 20 under 35 U.S.C. § 103 is reversed; and

b) new 35 U.S.C. § 103 rejections of claims 1, 2, 7 through 11 and 20 are entered pursuant to 37 CFR 1.196(b).

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This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR 1.196(b)

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT

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LAWRENCE J. STAAB)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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JOHN P. McQUADE)	
Administrative Patent Judge)	

Timothy J. Martin, P.C.
Carl Schaukovitch
9250 W. 5th Avenue, Suite 200
Lakewood, CO 80226